

to a method of assembling a device. Applicants' claims are directed to a method of assisting compromised barriers, such barriers having been created by an electrical box. Applicants' claims recite the addition of a fire retardant *gasket to* an electrical box. In newly added Claims 37-42, the electrical box, to which the fire retardant gasket has been added, is the responsible culprit for creating the "compromised barrier", set forth in the preamble in each of Applicants' claims.

*Rose* does not recite a method of assisting such compromised barriers. The Examiner fails to consider the preamble and the claimed limitations in light of the preamble. In the Advisory Action of 28 April 2003, the Examiner states that

Applicants' claims are directed to a method of assisting compromised barriers . . . doesn't constitute method assisting limitations because it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). (Page 2 of Advisory Action.)

The Examiner, by failing to consider the Federal Circuit's more recent rulings, misconstrues the law. A preamble properly limits the invention if it recites essential structure or steps, or if it is "necessary to give life, meaning, and vitality" to the claim." *Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808, 62 USPQ2d 1781, 1784 (Fed. Cir. 2002) (quoting *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999)). When limitations in the body of the claim rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention. See, e.g., *Electro Sci. Indus. v. Dynamic Details, Inc.*, 307 F.3d 1343, 1348, 64 USPQ2d 1781, 1783 (Fed. Cir. 2002); *Rapoport v. Dement*, 254 F.3d 1053, 1059, 59 USPQ2d 1215, 1219 (Fed. Cir. 2001); *Pitney Bowes*, 182 F.3d at 1306, 51 USPQ2d at 1166. The

preamble in Applicants' claims breathes life and meaning into the claim and incorporates by reference language which appears later in the claim. Element (a) of Claim 37 only makes sense in light of the claim preamble since the claimed "compromised barrier" in the preamble is the causative effect of the electrical box of step (a). *See further, Griffin v. Bertina*, 285 F.3d 1029, 62 USPQ2d 1431 (Fed. Cir. 2002) (preamble language will limit the claim if it recites not merely a context in which the invention may be used, but the essence of the invention without which performance of the recited steps is nothing but an academic exercise.)

In any event, the compromised barrier is not taught by *Rose*. In the Office Action of 31 December 2003, the Examiner states that FIG. 1 of *Rose* (the claimed process step d) of Applicants) teaches the process step of "at least partially reestablishing a fire rating of the barrier" (bridging paragraph of pages 2 and 3 of Office Action). *Rose* fails to disclose any method for assisting a compromised barrier, much less a step of "at least partially reestablishing a fire rating of the barrier." Step d) of Applicants' claims cannot be met by reference to a drawing in *Rose*. *Rose* is directed to an electrical box which is capable of suppressing fires. The Examiner's attempt to read the limitations of assembling the device of *Rose* into the method claims of Applicants must fail. A method of assembling an electrical box is separate and distinct from the claimed method of assisting a compromised barrier.

*Rose* further does not disclose the use of a fire retardant gasket. Note that the intumescent materials of *Rose* are applied onto a support (lines 7-20 of column 4) or "formed into a cover plate 26 by pouring a solution of the intumescent material 30 and a solvent into a suitable mold." (Lines 33-37 of column 4.) Alternatively, the intumescent material of *Rose* may be provided as a "pill, tablet or packet form". *Rose* does not disclose the use of a gasket for a fire retardant material.

The Examiner ignores the distinctions set forth in the previously submitted Declaration of Mr. Randy Clark that establishing and reestablishing of a fire rating of a barrier is distinct from suppressing a fire. As previously stated, the triad of fire protection includes the *separate and distinct* categories of detection, compartmentalization, and suppression. Compartmentalization is achieved by the erection of barriers such as walls to separate areas of occupancy. It is required by the various Codes to reestablish the fire rating of the barrier that has been breached, for example, where the breach was caused by inserting electrical boxes and other equipment into the barrier for insurance liability and other purposes. Suppression on the other hand requires a fire to suppress. *Rose* does not disclose, much less suggest, compromised barriers created by electrical boxes or the need to reestablish the fire rating created by such compromised barriers.

In contrast to *Rose*, the barrier recited in the present invention is designed and built to have a certain fire rating from one area on one side of the barrier to another area on another side of the barrier. *Rose* is concerned with an electrical box capable of suppressing a fire *within* the box. The present invention is concerned with a method of correcting the defect (loss of fire rating) in the compromised barrier *caused* by the box. *Rose* does not teach, show, or suggest any fire rating of the barrier or even any barrier to a fire located outside of the box. *Rose*, on the other hand, teaches the electrical box.

The Examiner's rejection should not be sustained therefore because each and every element set forth in Applicants' claims are not found, either expressly or inherently described, in *Rose*. See, *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP § 2131. *Kloster Speedsteel AB v. Crucible Inc.*, 231 USPQ 81, 84 (Fed. Cir. 1986), *on rehearing*, 231 USPQ 160 (Fed. Cir. 1986) (absence from a cited reference of any patent claim element negates anticipation of that claim by the reference).

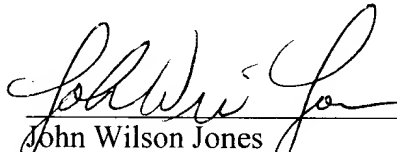
Examiner's Rejection of Claim 29 Under 35 U.S.C. § 103(a). The Examiner has further rejected Claim 29 under 35 U.S.C. § 103(a) as being unpatentable over *Rose* in view of Applicant's own admission. Applicants respectfully traverse this rejection.

The Examiner admits that *Rose* does not disclose fire resistant insulative material. In addition, *Rose* does not disclose a gasket as fire retardant. The combination of *Rose* and Applicants' own specification would not render the claims obvious because such combination would not teach of one skill in the art the claimed method of assisting the compromised barrier for reasons stated above.

**Conclusion.** The Examiner is respectfully requested to telephone the undersigned should he deem it prudent to expedite the prosecution of this application into a Notice of Allowance.

Respectfully submitted,

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37. A method of assisting a compromised barrier, comprising:
- a) installing into a fire-rated barrier an electrical box, the electrical box compromising the fire resistance of the fire-rated barrier;
  - b) introducing into the electrical box a fire retardant gasket; and
  - c) covering the electrical box with a faceplate.
38. The method of Claim 37, wherein the fire retardant gasket is adhered to the faceplate prior to covering the electrical box with the faceplate.
39. The method of Claim 37, wherein the fire retardant gasket is an intumescent gasket.
40. The method of Claim 37, wherein the fire retardant gasket is introduced to the electrical box without removing the electrical box from the fire resistant barrier.
41. The method of Claim 37, wherein the fire retardant gasket is a fire resistant insulative material.
42. The method of Claim 41, wherein the fire resistant insulative material is mineral wool, ceramic fiber or intumescent graphite.